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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,033	04/09/2001	Frank Venegas JR.	IDS-14302/14	8392

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EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant(s) 09/829,033	Applicant(s) VENEGAS, FRANK	
	Examiner Hargobind S Sawhney	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P n d f r R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on May 22, 2003 has been entered. Accordingly Claims 8 has have been amended.
2. the Appellant's brief under 37 CFR §1.192 filed on May 22, 2003 has been entered
3. The amendment filed on September 16, 2002 has been entered. Accordingly claims 1 and 9 have been amended.
4. Herewith, the Final Rejection mailed on December 19, 2002 is being withdrawn. This withdrawal is based on further examination of the instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307).

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Regarding claim 1, Moore discloses a lighted assembly 10 (Figure 4, column 2, line 18) further comprising:

- an elongated tubular body 11 having an open end 12, and a closed end 15 defining a cavity – enclosed by element 18 – (Figure 4);
- the open end 12 of the cavity receiving the stanchion 14 (Figures 1 and 4);
- a lighted assembly 10 (Figure 4, column 2, line 18) having a light source 17 (Figure 4, column 2, line 23) interconnected to a power source 22 (Figure 4, column 2, line 36);
- the light source 17 secured relative to the tubular body 11, and making its light visible exteriorly of the interior cavity (Figures 1 and 4; and
- an elongated tubular body receiving the stanchion in its cavity; and
- the open end of the elongated tubular body proximate – interpreted with similar thinking as that included in the recitation- to the ground surface.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore (U.S. Patent No. 5,121,307) by extending the length of the elongated tubular body , and accommodating entire stanchion with in itself, or making its open end contacting the ground, since such a modification would have involved a mere change in size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art.

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Regarding Claim 2, Moore does not disclose a lighted assembly 10 including a power source positioned external to the lighted stanchion cover. Instead, Moore teaches positioning of the power source within the cavity defined by the cover and the stanchion external wall (Figure 4). It would be have been obvious to one of ordinary skill in the art at the time of the invention to relocate the power source – batteries – external to the cavity, since it has been held that rearranging parts of an invention involves only routine skill in the art.

Regarding claims 3-6, Moore discloses the lighting assembly additionally including:

- an electronic circuit (Figures 1, 3 and 4) managing and controlling power for the device; and
- the lighted assembly 10 further having a light source receptacle (not shown) receiving the lamp 17;
- the lighted assembly 10 further comprising a plurality of photovoltaic devices 28 (Figure 4, column 2, line 50) supported by the elongated tubular body 11 (Figures 1 and 4); and
- the power source being a battery 22 (Figure 4, column 2, line 36).

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307) in view of Morse (U.S. Patent No. 3,855,924).

Regarding claims 7 and 8, Moore discloses a lighted assembly including an elongated tubular body with an open end and a closed end , and defining an interior

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cavity. However, Moore (U.S. Patent No. 5,121,307) does not teach the elongated tubular body displaying a message.

On the other hand, Morse (U.S. Patent No. 3,855,924) discloses a sign making stencil method applied for signs (Figures 2 and 3), and teaches a post carrying a message including stenciled letters (Figures 2 and 3, column 2, lines 45-48).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the lighted assembly of Moore (U.S. Patent No. 5,121,307) by providing stenciled message sign on the post as taught by Morse (U.S. Patent No. 3,855,924) for the benefit and advantage of displaying messages in simple and cost saving manner.

8. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (U.S. Patent No. 5,121,307) in view of Padilla et al.(U.S. Patent No. 5,121,307) et al. (U.S. Patent No. 5,121,307).

Regarding claims 9-11, Moore does not disclose a lighted assembly comprising a cover having tubular body including one or more light dispersing windows, and a message displayed with a plurality of light diodes further comprising.

On the other hand, Padilla et al.(U.S. Patent No. 5,121,307) teaches a lighting device 10 (Figure 1) comprising a tubular body 12 (Figures 1,5 and 6, column 4, lines 24-27) comprising a plurality of light emitting diodes (LEDs) 16 (Figures 1,5 and 6, column 4, line 29) emitting light through a plurality of light dispersing windows. In addition Padilla et al.(U.S. Patent No. 5,121,307) teach the light emitting diodes 16 being supported by the thickness of the tubular body of the cover 12 (Figures 7 and 8)

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It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the tubular cover of the lighted assembly of Moore with the tubular body taught by Padilla et al.(U.S. Patent No. 5,121,307) for benefits and advantages of eye- catching displays, and for traffic safety in dark.

Allowable Subject Matter

9. Claim 12 is allowed.

The prior art of record, including Moore (U.S. Patent No. 5,121,307) and Padilla et al.(U.S. Patent No. 5,121,307) et al. (U.S. Patent No. 5,121,307), fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose proper motivation for combining:

- the body of the cover having a second cavity defined by the inner and outer surfaces and the thickness; and
- the second cavity encapsulating a photo-luminescent mixture.

Response to Amendment

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10. Applicant's arguments, filed on September 16, 2002, with respect to the 35 U.S.C. 102(b) rejections of claims 1, 5 and 6 and 35 U.S.C. 103(b) rejections of claims 9-11 have been fully considered but they are not persuasive.

Argument: The stanchion cover of Moore could not extend down to the ground due to the wires and other obstacles that telephone and utility poles are designed to support.

Response: Application of the structural elements of the sleeve and its relative positioning taught by Moore is not limited to only telephone and utility poles, but equally applicable to stanchion, post or bollard or column. The examples of telephone and utility poles are considered herewith as an intended use.

Additionally, there appears to be no problem in further extending the length of the sleeve downwards.

Argument: The device taught by Moore is used at a high altitude, therefore, a message with stenciled letters on a tubular cover would not be visible.

Response: Messages painted with stenciled letters on electric utility poles and telephone poles are commonly found as a communication medium for traffic and observers. These messages can be painted at any elevation level to make them visible. Please refer to Morse (U.S. Patent No. 3,855,924) and other prior arts included in section 11 of this non-final office action.

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Argument: Padilla et al.(U.S. Patent No. 5,121,307) represents non-analogous art, as it being directed to a bicycle lighting device.

Response: In response to applicant's argument that Padilla et al.(U.S. Patent No. 5,121,307) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Padilla et al.(U.S. Patent No. 5,121,307) is reasonably pertinent to a lighting device including a plurality of light source supported on a tubular structure of a cover, which is the subject matter of the instant application. Thus teaching of Padilla et al.(U.S. Patent No. 5,121,307) is equally applicable and strongly solves the need of lighting a tubular cover for stanchion or bollard.

Argument: Examiner's conclusion of obviousness is bases on improper hindsight reasoning.

Response: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge

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which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, Padilla et al. (U.S. Patent No. 5,121,307) is reasonably pertinent to a lighting device including a plurality of light source supported on a tubular structure of a cover, which is the subject matter of the instant application.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aughenbaugh (U.S. Patent No. 5,956,875), Walker (U.S. Patent No. 4,817,316) Morganstern (U.S. Patent No. 4,454,671) and Erlich (U.S. Patent No. 4,479,319) each discloses a application and methods for stencil-type lettering applicable for posts.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 7:30 - 5:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

7/2/2003



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800